

Atty. Docket No. CQ10037
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/401,574

REMARKS

Claims 1-16 are all the claims pending in the application, claims 15 and 16 having been added to claim the disclosed invention more completely.

Applicants thank the Examiner for acknowledging their claim to priority under 35 U.S.C. § 119, and receipt of the certified copy of the priority document.

Claims 1, 3-7, 10-11, 12, and 14 stand rejected under 35 U.S.C. § 102(e) as anticipated by Barnett (USP 5,967,982). Claim 2 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Barnett in view of Protz (USP 4,666,298). Claims 8-9 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barnett in view of Montgomery (USP 5,015,070). Applicants respectfully traverse these rejections, and request reconsideration and allowance of the claims in view of the following arguments.

In relying on Barnett, the Examiner appears to consider claim 1 to be representative of a number of other claims including claim 7. However, Applicants submit that claims 1 and 7 are not the same. Claim 1 relates to deducing the location of a feature from the difference between the positions sensed in steps 2 and 4 of that claim. In contrast, claim 7 (which previously improperly depended from any of the preceding claims 1-6, and now depends only from claim 1) includes the further step of correcting the electronic representation of the input image in accordance with the location of the features determined in step (b) (see step (c)).

Barnett is concerned with locating the position of markers on diagnostic imaging equipment. Barnett is silent as to any image correction. Indeed, the principle behind Barnett is completely different from that of the invention. Barnett uses known markers as reference points

Atty. Docket No. CQ10037
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/401,574

to position one image with reference to another image (see col. 3, line 64 to col. 4, line 4). In contrast, the present invention is concerned with a method for determining the location of a feature in an image projection system, for example to determine whether the feature is in the image plane or another surface within an optical path.

It appears that the Examiner has equated the "feature" mentioned in the claim with Barnett's marker. Applicants submit that this interpretation represents such a broad reading of the term "feature" that it is inconsistent with the specification. Since Barnett fails to teach or suggest the claimed feature location, Applicants submit that claim 1 and its dependencies (claims 2-10) are patentable.

Claim 1 also is patentable over Barnett at least because of the requirement in step (3) for projecting the second image onto a detector with the lens in a second position laterally spaced from the first position. As can be seen in Figure 2 of Barnett, and as described in col. 4 beginning at line 36, there appears to be no lens provided. However, even if a lens were provided, the only movement described is a rotational movement of the source 22 from position 40 to position 42, and a corresponding movement of the detector 24. Consequently, there is no lateral movement of a lens.

In order to clarify this distinction still further, Applicants have amended claim 1, step (3) to refer to "the lens," so that the same lens is in a first position, and then a second position.

Claim 11 has also been amended to replace the second clause beginning "one or more lenses" with "a lens for projecting a first image of the feature onto the detector, the lens being laterally moveable to a second position for projecting a second image of the features onto the

Atty. Docket No. CQ10037
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/401,574

detector". Applicants submit that claim 11 (and hence dependent claims 12-14) are patentable at least for the reason that claim 1 is patentable.

New claims 15 and 16 have been added to further claim the invention. Support for these new claims can be found on page 2, lines 1-2.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Frank L. Bernstein

Frank L. Bernstein
Registration No. 31,484

SUGHRUE MION, PLLC
Telephone: (650) 625-8100
Facsimile: (650) 625-8110

MOUNTAIN VIEW OFFICE
23493
CUSTOMER NUMBER

Date: August 18, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.111 is being facsimile transmitted to the U.S. Patent and Trademark Office this 18th day of August, 2004.

Mariann Tam

Mariann Tam